

### REMARKS

Claims 1-24 are all the claims pending in the application. By this Amendment, to further clarify the invention, Applicant amends claims 1, 4, 8 and 15. In addition, in order to provide more varied protection, Applicant adds claims 23-24. Claims 23-24 are clearly supported throughout the Specification, for example see Fig. 1, pages 6-8 of the Specification.

The Examiner has not responded to Applicant's arguments presented in the Amendment filed on December 3, 2003. However, the Examiner rejected the claims in view of a newly found reference, U.S. Patent No. 6,029,065 to Shah. Therefore, Applicant believes that the rejection of the claims as being anticipated by Leung is overcome and that claims 1, 2, 4-9, 11-16, and 18-22 are only rejected in view of a newly found reference. Applicant respectfully traverses these new rejections and respectfully requests the Examiner to withdraw the rejections in view of the comments, which follow.

#### Claim Rejections under 35 U.S.C. § 102(e)

Claims 1, 2, 4-9, 11-16 and 18-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,029,065 to Shah (hereinafter "Shah"). Applicant respectfully traverses this rejection in view of the following remarks. Claim 1, 8, 15 and 22 are the only independent claims in this group. This response focuses initially on these independent claims.

To be an "anticipation" rejection under 35 U.S.C. § 102, the reference must teach every element and recitation of the Applicants' claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus,

the reference must clearly and unequivocally disclose every element and recitation of the claimed invention.

With respect to independent claim 1, as now amended, among a number of unique features not taught by the cited prior art reference, it recites: *a means for storing at least one set of protected primary provisioning data*. Independent claims 8 and 15, as now amended, recite that the provisioning data is data related to accessing a data network. In making this rejection, the Examiner relied on Shah. The Examiner indicated that the subject matter at column 8, lines 31-48 of Shah is similar to the recitations of claims 1, 8 and 15 (see page 2 of the Office Action). Applicant respectfully requests the Examiner to reconsider this rejection in view of the following.

An illustrative, non-limiting embodiment of the present invention, discloses a method and a telecommunications terminal operable to connect to a data network. The exemplary telecommunication terminal can change between access networks and/or users without losing the provisioning data by storing a protected provisioning data or a number of sets of protected provisioning data that cannot be modified without intervention from the user. Thereby, in this exemplary telecommunication terminal, there is no need to update the provisioning data to access the services of a data network each time the user roams between access networks and/or users. This passage is provided by way of an example only and is not intended to limit the scope of the claims in any way.

Shah teaches allowing a user to access features such as call waiting, conference calling, etc. by using the feature codes the subscriber is accustomed to (col. 1, lines 18 to 21, col. 4, lines

10 to 27). The feature codes are usually a numeric sequence, e.g. \*69 (col. 1, lines 26 to 39). The feature codes vary from network to network. Therefore, if the user is in a visiting network, he or she may be unable to access his or her feature codes (col. 1, lines 40 to 58). To enable the user to use the familiar feature codes, Shah teaches that when a mobile station (MS) accesses a visiting network, after the MS is registered, the feature codes of the visiting network are downloaded into the MS, for example, into the MS's temporary memory (col. 2, line 32 to col. 3, line 9). As a result, when the user wants to activate or deactivate a certain feature code, the MS matches the feature code of the home network with the downloaded feature code of the visiting network and forwards the feature code of the visiting network to the base station (col. 4, lines 10 to 27).

Moreover, Shah teaches that when a feature is subject to a subscription charge (an extended feature), and requires provisioning, notifying the user of a surcharge and activating this feature only if the user accepts (col. 4, lines 58 to 67).

However, Shah fails to teach or suggest having a protected provisioning data, as set forth in claim 1. Shah teaches that provisioning will occur each time the user enters a network (the user is registered). Moreover, Shah teaches that provisioning is required for the extended features. In other words, Shah is no different from the conventional prior art, which requires provisioning (communication with the BS) each time MS accesses a network. That is, Shah fails to teach or suggest storing protect provisioning data so that communication with BS is not necessary for registering a user.

With respect to the feature codes, Shah teaches that once the MS is registered, the base station will download information to the mobile station which will notify the mobile station of which network features are available and how they may be accessed in the local network (col. 3, lines 35 to 38). In other words, these feature codes are not the provisioning data but occurs after the provisioning.

In addition, with respect to the feature codes for extended features, it is not the provisioning data that is being protected but rather the user is asked if he would like to active this feature. In short, if the user likes to activate this extended feature, provisioning will always occur and the user cannot prevent the provisioning from being updated. Declining to activate an extended feature cannot be compared to having a protected provisioning code, which will not be updated/overwritten without user intervention. In short, downloading feature codes is not similar to primary provisioning data, which is data provided for accessing a network. In fact, in Shah these feature codes are downloaded after provisioning for regular features and before any provisioning can occur for extended features.

The Examiner alleges that col. 8, lines 31 to 48 teaches storing the protected provisioning data, as set forth in claim 1. Col. 8, lines 31 to 48 recite:

Once the mobile station is on the Traffic Channel, an OTASP Data Message is sent that an additional fee is charged for the use of the feature and requesting acknowledgment of acceptance. If accepted, a second OTASP Data Message is sent containing a Extended Feature Change Code (EFCC). If the EFCC matches the EFCC for the mobile station, it is verified by the mobile unit, after which

it may be used to unlock the mobile station, update the feature code(s) and store the updated feature code(s) into the phone's memory. After verification of the programmed data in accordance with OTASP processing, the process is terminated. If the user refuses the additional billing, no downloading will occur. A number of different EFCCs may be used for different feature codes so that the user may elect the feature codes individually to avoid being billed for access to all possible optional extended features when only one is desired, emphasis added.

Applicant respectfully point out that this passage of Shah only teaches that no update of the extended feature codes will take place without user permission. However, feature codes (e.g., “\*59” or “a menu option”) are not similar to the provisioning data, which is used, for example, to access a network. Moreover, Shah does not teach or suggest a primary provisioning data, which, for example, provides parameters for setting up a network or connection to a service provider. Shah teaches informing the user of an additional charges and confirming that the user still wants to use this extended feature. In short, Shah’s teaching of asking a user to confirm to active an extended is not similar to the primary provisioning data, as set forth in claim 1.

In addition, in Shah there is no mention of a data network or provisioning data to access this type of network, as set forth in claims 8 and 15. In sum, Shah deals with features provided by a telephone service carrier and is not related to provisioning data, as set forth in the independent claims 1, 8 and 15.

Therefore, for at least all of the foregoing reasons, Applicant respectfully submits that Shah does not anticipate the subject matter of claims 1, 8 and 15. Applicant therefore

respectfully requests the Examiner to withdraw this rejection of independent claims 1, 8 and 15 and its dependent claims 2, 4-7, 9, 11-14, 16, and 18-21.

Next, with respect to the independent claim 22, among a number of unique features not found in the cited reference, it recites: *backing up provisioning data for an access network, an access provider or a user*. The Examiner alleges that the same paragraph cited above, col. 8, lines 31 to 48 teaches the exemplary recitation of claim 22 (see page 3 of the Office Action). Applicant respectfully disagrees. This passage of Shah clearly teaches updating the feature codes if the user confirms activating a feature. Shah fails to teach or suggest any backups of the feature codes in the paragraph cited above or in any other place of the reference. Moreover, the feature codes for extended features are clearly not for access to a network or a provider and cannot be compared with provisioning data, as set forth in claim 22. In short, Shah fails to meet the recitation of claim 22.

Therefore, for at least these exemplary reasons, Applicant respectfully submits that Shah does not anticipate the subject matter of claim 22. Applicant therefore respectfully requests the Examiner to withdraw this rejection of independent claim 22.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 3, 10, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shah and further in view of U.S. Patent No. 6, 505,047 to Palkisto (hereinafter "Palkisto"). Applicant respectfully traverses this rejection on the following basis. Applicant respectfully traverses this rejection with respect to claims 3, 10 and 17, which are dependent upon claims 1, 8 and 15, respectively. Applicant has already demonstrated that Shah does not meet all the

requirements of independent claims 1, 8 and 15. Palkisto is relied upon only for its teaching of using Internet or wireless application protocols.

Specifically, Palkisto is similar to the prior art mentioned in the Application. It attempts to reduce the signaling load in the GPRS. GPRS comprises of a number of serving support nodes SGSN, which serve one gateway support node GGSN. These SGSN transmit routing area update information to and from the GGSN and HLR. Every time a MS moves from the area of an old support node to the area of a new support node, the routing update information is signaled to the network and specifically, to HLR where the location of the MS is stored. As a result, a significant signaling load is generated (col. 4, lines 18 to 35). Therefore, Palkisto proposes having the support node manage the mobility of the MS and maintain information on which data transmission IP address is serving each MS at each particular time. Information on a change in IP addresses within the area of the same support node is relayed to the gateway node but not to the HLR (col. 5, lines 2 to 7). However, Palkisto also fails to teach or suggest having a storage means for storing a set of protected primary provisioning data or protected provisioning data to access a network.

The Examiner asserts that it would have been obvious to combine Shah and Palkisto because the two are analogous arts and for increasing the efficiency of the communication system (see page 4 of the Office Action). However, the references attempt to solve two completely unrelated problems. Shah allows the user to use feature codes even when the MS is in a visiting network, whereas Palkisto deals with reducing the load of signaling to the HLR in a new network GPRS. In short, there is no motivation to combine these two unrelated references.

Moreover, an artisan of ordinary skill confronted with a problem of not being able to use feature codes in a visiting network would not have thought of consulting a reference like Palkisto, which deals with reducing the signaling load to HLR. In short, Shah and Palkisto cannot be validly combined with each other in a rejection under 35 U.S.C. § 103(a).

In addition, those skilled in the art would need to make additional modifications not taught in the prior art, in order to combine the references in the manner suggested by the Examiner. As explained above, neither Shah, nor Palkisto discloses storing means for storing a set of protected primary provisioning data or wherein the protected provisioning data is to access a data network. Therefore, storing means for storing a set of protected primary provisioning data or protected provisioning data for accessing a network are modifications not taught by even the combined teachings of these two references.

Clearly, Palkisto does not compensate for the above-identified deficiencies of Shah. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claims 1, 8 and 15. Since claims 3, 10 and 17 are dependent upon claims 1, 8 and 15, respectively, they may be patentable at least by virtue of their dependency.

#### New Claims

In order to provide more varied protection, Applicant adds claims 23-24. Claim 23 is clearly patentable over the prior art references cited by the Examiner at least because of its recitation of checking a storage for a protected provisioning data that cannot be modified without user intervention. Claim 24 is patentable at least by virtue of its dependency on claim 23.



Amendment Under 37 C.F.R. § 1.111  
U.S. Application No.: 09/716,273

Attorney Docket No.: Q61623

Conclusion and request for a telephone interview.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: April 13, 2004



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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q61623

Hubert HELAINE, et al.

Appln. No.: 09/716,273

Group Art Unit: 2686

Confirmation No.: 8432

Examiner: IQBAL, KHAWAR

Filed: November 21, 2000

For: HOME AND ROAMING PROVISIONING METHOD FOR MOBILE TERMINALS

EXCESS CLAIM FEE PAYMENT LETTER

RECEIVED

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

APR 16 2004

Technology Center 2600

Sir:

An Amendment Under 37 C.F.R. § 1.111 is attached hereto for concurrent filing in the above-identified application. The resulting excess claim fee has been calculated as shown below:

|             | After<br>Amendment |   | Highest No.<br>Previously<br>Paid For |   |   |   |         |   |          |
|-------------|--------------------|---|---------------------------------------|---|---|---|---------|---|----------|
| All Claims  | 24                 | - | 22                                    | = | 2 | X | \$18.00 | = | \$36.00  |
| Independent | 5                  | - | 4                                     | = | 1 | X | \$86.00 | = | \$86.00  |
| TOTAL       |                    |   |                                       |   |   |   |         | = | \$122.00 |

A check for the statutory fee of \$122.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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